



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,391	07/26/2001	Neil John Hursey	550-250	5033

7590 12/07/2004
NIXON & VANDERHYE P.C.
8th Floor
1100 North Glebe Road
Arlington, VA 22201-4714

EXAMINER

HENNING, MATTHEW T

ART UNIT	PAPER NUMBER
----------	--------------

2131

DATE MAILED: 12/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,391

Applicant(s)

HURSEY ET AL.

Examiner

Matthew T Henning

Art Unit

2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☒ Claim(s) 19-20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2131

This action is in response to the communication filed on 07/26/2001.

DETAILED ACTION

1. Claims 1-24 have been examined.

Title

2. The title of the invention is acceptable.

Priority

3. No claim for priority has been made for this application.
4. The effective filing date for the subject matter defined in the pending claims in this application is 07/26/2001.

Drawings

5. The drawings filed on 7/31/2002 are acceptable for examination proceedings.

Specification

6. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

7. The abstract of the disclosure is objected to because

Lines 4-6: "The sending of...mass mailing malware" must be removed, as it is not directed towards the technical disclosure of the invention or that which is new.

Correction is required. See MPEP § 608.01(b).

Claim Objections

8. The applicant is reminded that a series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

9. Claims 19-20 are objected to because claim 19 recites the limitation "Apparatus as claimed in claim 1" in line 1. The examiner feels that the claim was meant to depend on claim 17 but instead depends on claim 1 merely due to a typographical error. This would be consistent with claims 3 and 11 depending on claims 1 and 9 because claim 17 is the independent apparatus claim. Claim 20 is objected to by virtue of its dependency to claim 19. For the purposes of searching art, the examiner will assume the claim was meant to depend on claim 17.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2131

11. Claims 1-3, 5, 7, 9-11, 13, 15, 17-19, 21, and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Marsh (US Patent Number 6,763,462).

Art Unit: 2131

12. Regarding claims 1, 9, and 17, Marsh disclosed a method, apparatus, and program (See Marsh Claims) operable to control an e-mail client computer to detect e-mail propagated malware (See Marsh Abstract), comprising: e-mail generating logic operable to generate an e-mail message (See Marsh Col. 2 Lines 11-25); comparison logic operable to compare said e-mail message with at least one of an address book of a sender of said e-mail message (See Marsh Col. 1 Lines 61-64 and Col. 2 Lines 44-46) and one or more previously generated e-mail messages from said client computer (See Marsh Col. 3 Lines 62-65); and identifying logic operable to identify said e-mail message as potentially containing malware if at least one of: (i) said e-mail message is being sent to more than a threshold number of addressees specified within said address book (See Marsh Col. 1 Lines 61-64 and Col. 2 Lines 44-46, and Col. 3 Lines 13-34); (ii) said e-mail message contains message content having at least a threshold level of similarity to message content of said previously generated e-mail messages being sent to more than a threshold number of addressees specified within said address book; and (iii) said e-mail message contains message content having at least a threshold level of similarity to message content of more than a threshold number of said previously generated e-mail messages.

13. Regarding claims 2, 10, and 18, Marsh disclosed that wherein said e-mail message specifies a plurality of addressees, said comparison logic being operable to compare said plurality of addressees with said e-mail address book to determine if said at least a threshold number of addressees has been exceeded (See Marsh Col. 2 Lines 39-46 and Col. 3 Lines 15-34).

14. Regarding claims 3, 11, and 19, Marsh disclosed that said at least a threshold number of addressees is specified as a proportion of addressees within said address book (See Marsh Col. 2 Lines 58-61).

Art Unit: 2131

15. Regarding claims 5, 13, and 21, Marsh disclosed quarantine queue logic operable to hold said previously generated e-mail messages in a quarantine queue for at least a predetermined quarantine period prior to being sent from said client computer (See Marsh Col. 3 Lines 18-24, 35-43 and 50-57 wherein Marsh disclosed comparing outgoing messages for a certain period of time, two minutes, and if the threshold was reached during that time, the message was deleted and not sent, which implied that the message was held for the specified period of time before being sent).

16. Regarding claims 7, 15, and 23, Marsh disclosed confirmation input logic operable when said e-mail message is identified as potentially containing malware to generate a user message seeking a confirmation input from a user of said client computer before said e-mail message is sent (See Marsh Col. 3 Lines 35-43).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. Claims 4, 6, 12, 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh as applied to claims 1, 9, and 17 above, and further in view of Bates et al. (US Patent Number 6,785,732) hereinafter referred to as Bates.

Marsh disclosed both a proportion of addresses (See rejection of claim 3 above) and a specified time period (See rejection of claim 7 above) but failed to disclose the proportion and the time period could be user specified.

Bates teaches that in a virus checker, a users can specify preferences about the virus checking (See Bates Col. 8 Lines 49).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Bates in the virus detector of Marsh by allowing the user to specify the proportion and the time period used for determining a threat. This would have been obvious because the ordinary person skilled in the art would have been motivated to allow the user of the virus checker to specify how the checker would operate.

19. Claims 8, 16, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marsh as applied to claims 1, 9, and 17 above, and further in view of Kouznetsov (US Patent Number 6,725,377).

Marsh disclosed sending alert an alert to a user upon detection of possible virus activity (See Col. 3 Lines 18-22), but failed to disclose sending an alert to an administrator upon detection of possible virus activity.

Kouznetsov teaches that in computer intrusion detection systems, when attack characteristics are detected, it is typical to notify an administrator of the detection (See Kouznetsov Col. 1 Paragraph 6).

It would have been obvious to the ordinary person skilled in the art at the time of invention to employ the teachings of Kouznetsov in the virus detection system of Marsh by alerting an administrator of detected possible virus activity. This would have been obvious

Art Unit: 2131

because the ordinary person skilled in the art would have been motivated to provide the administrator with the knowledge of the possible attack in order for the administrator to take appropriate action.

Conclusion

20. Claims 1-24 have been rejected.

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Shipp (Patent Application Publication Number 2004/0054498) disclosed a method for detecting a virus outbreak by monitoring e-mail traffic patterns, including monitoring for duplicate or similar messages being sent in a specified period of time.

b. Hockey (Patent Application Publication Number 2004/0064515) disclosed a method for detecting denial of service attacks, worms, and spam by monitoring for duplicate messages using message digests.

c. Algomy et al. (Patent Application publication Number 2002/0194489) disclosed a method for containing viruses including monitoring for messages being sent to decoy addresses in an address book.

d. Milliken et al. (Patent Application Publication Number 2004/0073617) disclosed a method for monitoring e-mail for virus activity involving checking for replicated content.

22. Please direct all inquiries concerning this communication to Matthew Henning whose telephone number is (571) 272-3790. The examiner can normally be reached Monday-Friday from 9am to 4pm, EST.

Art Unit: 2131

If attempts to reach examiner by telephone are unsuccessful, the examiner's acting supervisor, Ayaz Sheikh, can be reached at (571) 272-3795. The fax phone number for this group is (703) 305-3718.

Any inquiry of general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



Matthew Henning
Assistant Examiner
Art Unit 2131

12/2/04



Art 2131

12/2/04